Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BERND WILLING

Appeal No. 2002-0319
Application No. 09/195,005

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3 and 6, which are all of the claims pending in this application.

We REVERSE AND ENTER A NEW REJECTION UNDER 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a device for inserting and removing work stations circulating on a chain. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

There are no prior art references applied against the claims.

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Examiner's Rejection

According to the examiner (Answer, page 3), one of ordinary skill in the art would not have been able to make and use the invention because the following are not known:

> (1) How the system knows when to operate switches 27 and 37 to timely divert the selected rollers 8a and 8b of the selected wagon;
>
> (2) How switches 37 and 37' know when there is an opening in which to insert a wagon;
>
> (3) How the wagon is inserted as claimed in claim 3 via pushing by the following wagon if the insertion guide has a high speed drive as discussed on page 4 of the specification at lines 24-30; and
>
> (4) What is the design of the load-dependent high speed drive on the insertion track discussed on page 4, lines 24-30.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

The first and second items on the examiner's list have to do, respectively, with the removal of a wagon from the track and the insertion of a wagon onto the track. With regard to both, it is our view that one of ordinary skill in the art would possess sufficient skill to cause the switchable tongues (27, 27', 37, 37') to operate at the proper time,

either manually or by automatic sensing, to disengage or engage the desired wagon from the chain or to the chain when it is in position to do so and, in the latter case, when an empty space is detected. We base this conclusion on the explanation of the invention provided on pages 5 and 6 of the specification and the depiction of the apparatus in the drawings, taken in view of the skill which should be accorded to the artisan.

The third and fourth issues raised by the examiner have to do with the high speed drive disclosed as the means for moving a wagon from the insertion guide rail back into line on the chain. This element was recited in claims 4 and 5, and the appellant's response to these two issues was to cancel claims 4 and 5, which in his view rendered them moot. Since the claims no longer include the load-dependent drive having a maximum speed that is higher than the speed of the chain, we agree with the appellant that these items in the rejection cannot be sustained.

We will not sustain the examiner's rejection under 35 U.S.C. § 112, first paragraph.

New Rejection By The Board

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection:

Claims 1, 2, 3 and 6 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following elements are recited in the claims but their structure, operation, and manner of interaction with one another are not described in the specification:

(1) The "detachable connection element" in line 4 of claim 1.

(2) The "coupling element" in line 8 of claim 1.

(3) The "connecting element" in line 9 of claim 1.

(4) The "detachable element" in line 13 of claim 1.

(5) The "carrier cage" in line 2 of claim 6.

Further in this regard, the specification fails to describe how the wagons are removably connected to and disconnected from the circulating chain. Nor does it describe a mechanism for moving the wagons along the removal guide track or along the insertion drive track, which would appear to be necessary for the operation of the claimed system, or how the wagons are removably connected to these tracks.

The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) and In re Wands, 858 F.2d 731, 737 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976). Moreover, the specification must teach those of skill in the art how to make and use the invention as broadly as it is claimed. See In re Goodman, 11 F.3d 1046, 1050, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993).

By virtue of the fact that there is a total lack of description of the items referred to above in the specification, it is our view that one of ordinary skill in the art would not be able to make or use the claimed invention without undue experimentation, and therefore the claims fail to comply with the first paragraph of Section 112.

CONCLUSION

The examiner's rejection under 35 U.S.C. § 112, first paragraph, is not sustained.

The decision of the examiner therefore is reversed.

Pursuant to 37 CFR § 1.196(b), a new rejection of claims 1, 2, 3 and 6 under 35 U.S.C. § 112, first paragraph, has been entered.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED 37 CFR § 1.196(b)

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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